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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,179	05/23/2000	Udo Gori	PM268103/990049PK	3953
909	7590	01/29/2004	EXAMINER	
PILLSBURY WINTHROP, LLP			LEE, RIA	
P.O. BOX 10500				
MCLEAN, VA 22102			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

**Office Action Summary**

Application No.

09/576,179

Applicant(s)

GORL ET AL.

Examiner

Rip A. Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,16 and 17 is/are rejected.
- 7) ☒ Claim(s) 2, 5 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

This office action follows a response filed on November 13, 2003. Applicants have amended 1 to include the condition that filler is added as a suspension with a particular suspension density.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 3, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sommer *et al.* in view of Wolff *et al.* for the same reasons set forth in the previous office action. Regarding the amended claim material, Sommer *et al.* also indicates that filler suspensions with solids content of 2-10 wt % are used (col. 3, lines 47-54). Therefore, the skilled artisan would have found it obvious to arrive at the subject matter of the present claims since it is taught in Sommer *et al.*

***Response to Arguments***

4. Applicants traverse the rejection of claims under 35 U.S.C. 103(a) relying on the reference, Smigerski *et al.* Smigerski *et al.* does not teach addition of filler in a single step, as presently claimed. It is noted for the record that where product by process claims are rejected over a prior art product that appears to be the same, the burden is shifted to the Applicant to establish an unobviousness difference, even if the production processes are different.<sup>1</sup> Applicants submit that the rubber powder of the prior art resembles a core-shell particle. In contrast, the rubber powder of the present invention contains filler distributed uniformly throughout the particle. Hence, the difference between the two methods is significant. As such, the three rejections relying on Smigerski *et al.* have been withdrawn.

4. Applicants traverse the rejection of claims under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,250,082 to Sommer *et al.* in view of U.S. Patent No. 5,159,009 to Wolff *et al.* Applicants maintain that the upper limit of the range claimed in Sommer *et al.* would not be used because none of the examples shows use of filler in an amount greater than 120 phr.

In response, it is well settled that a reference must be considered in its entirety and that the disclosure of a reference is not limited to preferred embodiments or specific working examples therein.<sup>2</sup> Rather, the references are relevant for all that they contain.<sup>2</sup>

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<sup>1</sup> *In re Marosi*, 218 USPQ 298 (Fed. Cir. 1983).

<sup>2</sup> *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976).

<sup>3</sup> *In re Heck*, 669 F.2d 1331, 1333, 216 USPQ 1038, 1039 (Fed. Cir. 1988).

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Especially relevant material can be found in the claims, and claim 7 of Sommer *et al.* recites use of carbon black filler in the amount of 20-400 pw and silica in an amount of 20-500 pw. Therefore, it is maintained that use of the claimed amount of filler is obvious in view of the teachings of the prior art. Applicants also state that neither secondary reference overcomes the limitations Sommer *et al.* since they do not disclose higher filler concentrations. In response to Applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.<sup>4</sup> Finally, Applicants claim that the skilled artisan would not have found it obvious to combine teachings because the reactions between silicic acid and organosilane coupling agent are extremely complex, and therefore, there would be no expectation of success in doing so. It is noted here, that reaction complexity has nothing to do with unobviousness. Documentation of use of organosilane coupling agent for inorganic oxide filler in rubber compositions is abundant in the literature, and such practice is well-established in the art. The Wolff *et al.* reference is cited to support this notion. Complexity of reaction mechanism and kinetics at the carrier surface notwithstanding, one having ordinary skill in the the art of making rubber compositions would have found it obvious to use an organosilane coupling agent with silicic acid filler, especially in view of Wolff *et al.*

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<sup>4</sup> *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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5. Applicants traverse the rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Sommer *et al.* in view of Wolff *et al.* and further in view of U.S. Patent No. 5,216,055 to Goerl *et al.* Applicants have not shown why it is not obvious to incorporate flame retardant into the compositions of the prior art, especially when such practice is elucidated in Goerl *et al.*

***Allowable Subject Matter***

6. Claims 2, 5, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. In view of the discussion in paragraphs 5 and 6, the rejections of record have not been withdrawn.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-1104.

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January 20, 2004



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